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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,274	07/17/2003	Michelle Klippen	14377.1US01	4206

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EXAMINER	
LOPEZ, MICHELLE	
ART UNIT	**PAPER NUMBER**
3721	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,274	KLIPPEN ET AL.	
	Examiner	Art Unit	
	Michelle Lopez	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-44* is/are pending in the application.

4a) Of the above claim(s) *35-44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 18.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 have been canceled.

2. New claims 23-44 have been added.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 23-34 drawn to a method of compressing and packaging, classified in class 53, subclass 434.

II. Claims 38-42 drawn to a method of compressing and packaging, classified in class 53, subclass 557.

III. Claims 35-37 and 43-44 drawn to a packaged absorbent article, classified in class 604, subclass 385.02.

The inventions are independent or distinct, each from the other because:

Inventions (I, II) and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another an materially different process, see, e.g. paragraphs 29-32 of the instant application, i.e. the diaper and packaging material "can be assembled in a variety of different ways", e.g. no vacuum to compress and/or no heating.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the

instant case, subcombination I has separate utility such as the step of drawing a vacuum. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

4. During a telephone conversation with Chad Tillman on February 13, 2006 a provisional election was made with traverse to prosecute the invention I, claims 23-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 35-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 24, 29-30 and 33-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 is indefinite, since it is unclear whether the separate flat panels are fed from two different sources. Claim 24 recites the limitation "the size". Claim 30 recites the limitation "the order of magnitude of hundreds of millibars", and claims 32-34 recite the limitation "the volume". There is insufficient antecedent basis for these limitations in the claims. The limitation "the order of magnitude of hundreds of millibars" renders claim 30 indefinite since it is unclear to what it is related to and is not clear what is meant by. In claim 33, a 40% or more could be any value equal or bigger than 40%. Also, in claim 34, a 55% or more could be any value equal or bigger than 55%.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 23, 25, 27, 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bercaits (6,370,843).

Bercaits discloses the invention substantially as claimed including a method of compressing an article with the process steps of (a) disposing an article within a package, the

package comprising a heat shrinkable material; (b) drawing a vacuum within the package to compress the article; (c) heat-shrink wrapping the article; and (d) sealing the package (see col.5; 33-48 and col. 6; 3-8).

The article of Bercaits is deemed to be a "sanitary absorbent article", as broadly claimed since Bercaits discloses a flexible sheet material in particular a woven cloth.

With respect to claim 25, Bercaits discloses wherein the heat shrink-wrapping and compression process is performed prior the sealing process as shown in col. 6; 3-8.

With respect to claim 27, Bercaits discloses wherein the step of sealing the package is performed during performance of heating the package as shown in col. 6; 3-8.

With respect to claims 30-31, Bercaits does not specifically disclose drawing a vacuum at a specific pressure, i.e. hundreds of millibars (claim 30) and about 350 millibars (claim 31). However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the step of drawing a vacuum at a specific range of pressure, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

With respect to claims 32-34, Bercaits discloses the process step of compressing an article to be packaged at a desired reduced volume, but does not specifically discloses wherein the volume of the article is reduced by the method by about 30% to 70% (claim 32), 40% or more (claim 33) and 55% or more (claim 34). However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have reduce an article to a specific reduced volume, since it has been held that where the general conditions of a claim are

disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bercaits (6,370,843) in view of Merry (5,172,629).

Bercaits discloses the invention substantially as claimed except for the step of compressing the article to reduce its size prior to the step of dispensing the article within a package. However, Merry discloses the step of compressing an article to reduce its size prior to the step of disposing the article within a package 24 for the purpose of producing a stable, rigid, compacted article. In view of Merry, it would have been obvious to one having ordinary skill in the art to have provided Bercaits' invention including a method of compressing and shrink-wrapping a sanitary absorbent article in order to produce a stable, rigid, compacted article.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bercaits (6,370,843) in view of Yamamoto (3,643,308).

Bercaits discloses the invention substantially as claimed, but does not specifically disclose wherein the process step of sealing the package is performed prior the step of heating the package. However, Yamamoto teaches a process step of sealing a package prior to the step of heating the package as shown in Figs. 1-2 for the purpose of compressing an article within a heat-shrink wrap. In view of Yamamoto, it would have been obvious to one having ordinary skill in the art to have provided Bercaits' invention with the process step of sealing the package prior to the step of heating the package in order to compress an article within a heat-shrink wrap.

9. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bercaits (6,370,843) in view of Esteves (5,590,509).

Bercaits discloses the invention substantially as claimed except that the package is formed from a tubular sheet of material having and endless wall with two separate panels as broadly interpreted. However, Esteves teaches the concept of forming a package from a tubular sheet of material having and endless wall with two separate panels 2 for the purpose of continuously packaging an article. In view of Steves, it would have been obvious to one having ordinary skill in the art to have provided Bercaits' invention with a package formed from a tubular sheet of material having and endless wall with two separate panels 2 in order to continuously packaging an article.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN SIPOS
PRIMARY EXAMINER